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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,681	07/10/2006	Udi Chatow	200311091-2	4703
22879 7590 09/21/2009 HEWLETT-PACKARD COMPANY Intellectual Property Administration 3404 E. Harmony Road Mail Stop 35 FORT COLLINS, CO 80528			EXAMINER BURNEY, RACHEL L	
			ART UNIT 1795	PAPER NUMBER
			NOTIFICATION DATE 09/21/2009	DELIVERY MODE ELECTRONIC

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In re application of :
Chatow et al. : DECISION ON
Serial No. 10/585,681 : PETITION
Filed: July 10, 2006 :
For: PRINTING OF IMAGES WITH SELECTIVE GLOSS AND TONERS THEREFORE

This is a decision on the PETITION UNDER 37 CFR 1.144 REQUESTING WITHDRAWAL OF THE RESTRICTION REQUIREMENT made final in the office action mailed December 24, 2008.

On September 16, 2008, the examiner made a restriction requirement under 35 USC 121 and 372 based upon a finding that the claims lack unity of invention as defined in PCT Rules 13.1 and 13.2. In a response to the requirement filed on October 15, 2008, Applicants traversed the requirement with respect to Groups I and III. The examiner maintained the restriction requirement in an office action mailed on December 24, 2008 and made the requirement final.

The instant petition was filed on March 19, 2009 requesting that the requirement for restriction between Groups I and III be withdrawn. Petitioner argues that the restriction between Groups I and III is improper because claim 34 (Group III) expressly requires the limitations of claim 1 (Group I) by specific reference to claim 1 (see line 5 of claim 34). The Petitioner further argues that Vanbesien et al. cannot be relied on to break unity of invention because it fails to disclose a liquid toner, which is deemed to be a shared common technical feature of the Groups.

DECISION

The instant application has been filed under 35 USC 371 as a national phase application of PCT/IL03/01035 and as such is subject to the unity requirements set out in PCT Rules 13.1 – 13.4 and 37 CFR 1.475, as well as the PCT Administrative Instructions, Annex B. MPEP 1893.03(d) permits groupings of claims which are linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding technical feature.

The PCT Administrative Instructions, Annex B, Part 1 at (b) state that “the special technical features” common to all groupings of inventions shall be defined, as in PCT Rule 13.2, to mean,

“those technical features which each of the claimed inventions, considered as a whole, makes over the prior art.”

Group I and Group III do share a common technical feature, i.e. the matte liquid toner of claim 1. However, the non-final office action of December 24, 2009 set forth an anticipation rejection of claim 1 over prior art, i.e. Vanbesien et al. (USPN 6,562,541). Thus, the holding of lack of unity of inventions is deemed to be proper, because the shared technical features do not make a contribution over the prior art as required by PCT Rule 13.2.

Accordingly, the petition to withdraw the restriction requirement is **DENIED**. It is noted however, that if at such time a determination is made that the common technical feature is not disclosed by the prior art, withdrawal of said holding and rejoinder of the claims of Group III would be appropriate.

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